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EXAMINER

PICKETT, JOHN G

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/066,954
Filing Date: February 04, 2002
Appellant(s): LEWIN ET AL.

MAILED
JUN 29 2007
Group 3700

Margaret S. Millikin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 March 2007 appealing from the Office action mailed 20 June 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 15-18 appears on page 19, Claims Appendix, of the appellant's brief.

The minor errors are as follows:

In claim 15, line 2, the passage "closure;" should read --closure; and--.

The "and" was present in the amendment filed 5 April 2006, upon which the Final Rejection was based.

(8) Evidence Relied Upon

| | | |
|--------------|--------------------|---------|
| US 4,569,471 | Ingemansson et al. | 02-1986 |
| US 3,968,877 | Mattis | 07-1976 |
| US 3,670,949 | Galanes | 06-1972 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingemansson et al (US 4,569,471; hereinafter Ingemansson).

Ingemansson discloses glass strands fed into a muffler outer cylinder **14**. The muffler outer cylinder is considered a container. As the strands are fed, they are blown with a nozzle **9**, causing the threads to blow apart so as to form a wool-like texture (Col.

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3, lines 40-44). Accordingly, the filled strand is considered texturized. After the glass strands have been deposited into the outer cylinder, a cover plate is placed over the opening for transport (see Col. 3, line 67 to Col. 4, line 7). Accordingly, the cover plate is considered a closure. Figures 1 and 3 show the fibers as looped/coiled and since the length of the container is a much greater dimension than a strand loop-coil, the deposit of the strand will be in multiple layers. The strand of Ingemansson is inherently capable of being removed for subsequent use since Ingemansson lacks any permanent fastening means; the remove-to-use feature is an "intended use" limitation.

Ingemansson does not expressly disclose the density of the glass strand within the container.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the glass strand in the claimed densities because applicant has not disclosed that the specific density provides an advantage, is used for a particular purpose, or solves a stated problem. Absent a showing of unexpected results, one of ordinary skill in the art, would have expected applicant's invention to perform equally well with a large range of densities because the specific density would only be dependent on the amount of glass strand forced into the container.

Therefore, it would have been an obvious matter of design choice to provide the glass strand of Ingemansson in the claimed density to obtain the invention as specified in claim 15. As noted by the applicant on page 8, lines 18-20 of their specification, "[t]he

artisan will appreciate that there are many possible variations on the particular embodiment described...that would be consistent with the principles of the invention."

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingemansson in view of Mattis (US 3,398,877).

As noted above, Ingemansson discloses glass strands fed into a muffler outer cylinder **14**. The muffler outer cylinder is considered a container. As the strands are fed, they are blown with a nozzle **9**, causing the threads to blow apart so as to form a wool-like texture (Col. 3, lines 40-44). Accordingly, the filled strand is considered texturized. After the glass strands have been deposited into the outer cylinder, a cover plate is placed over the opening for transport (see Col. 3, line 67 to Col. 4, line 7). Accordingly, the cover plate is considered a closure. However, Ingemansson also suggests that the glass fibers may be directly blown into a package (Col. 4, lines 35-39) for any purpose whatsoever.

Mattis discloses a container for strand that has a closure (flaps of Figures 2 and 3) that is removable by cutting the sealing tape, and is used to provide a suitable package for the purpose of storing and transporting strand (see for example, the Abstract). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the glass fibers of Ingemansson in a package as taught by Mattis for the storage and transport of the strands. As presented above, Ingemansson teaches looped/coiled and layered glass strand.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the glass strand in the claimed densities because applicant has not disclosed that the specific density provides an advantage, is used for a particular purpose, or solves a stated problem. Absent a showing of unexpected results, one of ordinary skill in the art, would have expected applicant's invention to perform equally well with a large range of densities because the specific density would only be dependent on the amount of glass strand forced into the container.

Therefore, it would have been an obvious matter of design choice to provide the glass strand of Ingemansson-Mattis in the claimed density to obtain the invention as specified in claim 15.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingemansson-Mattis as applied to claim 15 above, and further in view of Galanes (US 3,670,949).

Ingemansson-Mattis discloses the claimed invention except for the corrugated material. Galanes discloses that corrugated cardboard was a suitable material for cartons for improved wall strength (see Col. 4, lines 55-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Ingemansson-Mattis in a corrugated material in order to improve the wall strength of the container. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

(10) Response to Argument

Appellant's initial argument concerns whether Ingemansson is analogous art. Although Ingemansson is directed to filling a muffler with texturized glass strand, it is also directed to packaging the strand within a package *per se* (see for example Col. 4, lines 35-39, whereby the strands are directly blown into a "package" instead of a muffler). Appellant appears to ignore this passage in determining whether Ingemansson is analogous. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). Ingemansson represents a cross-art reference, which is relevant art within both the muffler and packaging arts. As the appellant's stated field of endeavor is the packaging art, Ingemansson is analogous art.

In response to the appellant's arguments that Ingemansson does not disclose a removable closure, in the rejection based upon Ingemansson alone, it is noted that Ingemansson discloses that after the glass strands have been deposited into the outer cylinder, a cover plate is placed over the opening for transport (see Col. 3, line 67 to Col. 4, line 7). Accordingly, the cover plate is considered a closure. Moreover, Ingemansson uses the terminology "a cover plate is **temporarily** placed over the opening" (emphasis added), which would inherently mean "removable" to one of ordinary skill in the art. "[I]n considering the disclosure of a reference, it is proper to

take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

When used in combination with Mattis, Mattis (the package into which the strands are blown) discloses removable closures in the form of flaps (Figures 2 & 3); it is noted that closure flaps are considered removable by the appellant (see Appellant's Brief at page 7, lines 3-4).

In response to the appellant's arguments that Ingemansson does not disclose withdrawal and subsequent use of the strand, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). The strand of Ingemansson is inherently capable of being removed for subsequent use since Ingemansson lacks any sort of fastening means; there is simply nothing physically preventing the removal of the strands. Like rope loosely retained in a bucket, the strands of Ingemansson are fully capable of being removed.

In response to the appellant's argument concerning the density of the texturized strands, appellant's reliance on the evidence of Exhibit A is completely irrelevant to the issues at hand and serves only to muddy the waters before the board. Prosecution of

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this application was previously reopened to precisely clarify this issue. A rejection under 112, 2nd paragraph was presented in the Office Action of 10 January 2006; applicant amended the claim and stated the density is with respect to the coiled form within the container in the response of 5 April 2006. The density recited in claim 15 is with respect to the amount of strand compressed into the container (see for example page 8, line 15 of the appellant's specification), and NOT the density of the material itself. Exhibit A is concerned only with the density of the material itself and is completely irrelevant to the rejection at hand.

With respect to the amount of strand compressed within the container, appellant states that the "densities are relevant because they demonstrate that Appellant's invention is a package of texturized glass strands for later use". Appellant appears to be arguing that the specific density is claimed in order to allow the strands to be placed in a package, yet Ingemansson clearly also places the strands within a package (Col. 4, lines 35-39). It is not seen how the specific claimed density provides an advantage, is used for a particular purpose, or solves some stated problem. Absent a showing of unexpected results, one of ordinary skill in the art, would have expected applicant's invention to perform equally well with a large range of densities because the specific density would only be dependent on the amount of glass strand forced into the container. Moreover, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

In response to appellant's argument that Ingemansson teaches away from packaging the strand in a container such as disclosed by Mattis, Ingemansson specifically teaches packaging the strand within a package *per se* (see for example Col. 4, lines 35-39, whereby the strands are directly blown into a "package" instead of a muffler). Again, appellant appears to ignore this passage. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

In response to the appellant's arguments concerning Galanes, Ingemansson specifically teaches packaging the strand within a package *per se* (see for example Col. 4, lines 35-39, whereby the strands are directly blown into a "package" instead of a muffler). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

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knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



J. Gregory Pickett
Examiner

Conferees:

Mickey Yu
SPE



Nathan J. Newhouse
SPE